

Application No.: 10/822,726

Docket No.: 2336-265

REMARKS

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Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 1-2, 5, 7-11 and 13-24 are pending in the application. Claims 3, 4, 6, 12 have been cancelled without prejudice or disclaimer. Independent claim 1 has been amended to include claim 3, now cancelled. Claims 1-2, 5, 7-8, 10-11 and 13-15 have been amended to improve claim language. New claims 16-24 have been added to provide Applicants with the scope of protection to which they are believed entitled. The Abstract has been revised to be compliant with commonly accepted US patent practice. No new matter has been introduced through the foregoing amendments.

The 35 U.S.C. 103(a) rejection of claims 1-15 as being obvious over Applicant's Admitted Prior Art (APA) in view of *Bishop* (U.S. Patent No. 6,441,360) is noted. Applicants respectfully traverse the rejection of at least claim 9.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See *MPEP*, section 2143 quoting *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that at least the first and third criteria have not been met in the Examiner's rejection of claim 9.

Independent claim 9 recites, among other things, a shutter member arranged between the filter and the single collimator to attenuate the specific wavelength optical signal transmitted through the filter. APA discloses, in FIG. 2, a filter 20 and a single collimator 30, both of which are

Application No.: 10/822,726

Docket No.: 2336-265

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part of demultiplexer 1a. *APA* further discloses, in FIG. 1, an attenuator 50 located outside demultiplexer 1a. Thus, if attenuator 50 of *APA* was replaceable by a MEMS attenuator as taught by *Bishop*, the *Bishop* MEMS attenuator and its shutter would be necessarily located at the same place as the *APA* attenuator 50, i.e., outside demultiplexer 1a. The resulting combined device would fail to include a shutter member arranged between elements of the *APA* demultiplexer 1a, i.e., filter 20 and single collimator 30, as presently claimed. Therefore, the third criterion has not been met.

What is lacking in the Examiner's rationale is a suggestion or motivation to have the shutter of *Bishop* MEMS attenuator positioned between the *APA* filter 20 and single collimator 30 in the presently claimed manner. Without such a suggestion or motivation, the currently applied references cannot properly be further modified (e.g., by moving the *Bishop* shutter from the location of *APA*'s element 50 to the gap between filter 20 and single collimator 30) to arrive at the claimed invention. Therefore, the first criterion has not been met.

Accordingly, Applicants respectfully submit that original claim 9 is patentable over the applied references, and request that the rejection of claim 9 be withdrawn.

Claims 10-11 and 13-15 depend from claim 9, and are considered patentable at least for the reasons advanced with respect to claim 9.

Amended independent claim 1 includes the limitation of original claim 3, i.e., a shutter member moveable into and out of said gap... between the filter and the lens. Amended claim 1 finds support in at least FIGs. 3a-3b, 5a and 6. Again, it should be noted that the Examiner's combined device would necessarily include the *Bishop* MEMS attenuator and its shutter being located at the same place as the *APA* attenuator 50, i.e., not between the *APA* filter 20 and lens 32 as presently claimed. Amended claim 1 is thus patentable over the applied art of record.

Claims 2, 5, 7-8 and 16-18 depend from claim 1, and are considered patentable at least for the reason advanced with respect to amended claim 1.

New independent claim 19 recites, among other things, a shutter member moveable into and out of said gap... between the lens and the input end of said transmitting optical fiber. New independent claim 19 finds support in at least FIGs. 4a-4b and 5b. Again, it should be noted that the

Application No.: 10/822,726Docket No.: 2336-265**BEST AVAILABLE COPY**

Examiner's combined device would necessarily include the *Bishop* MEMS attenuator and its shutter being located at the same place as the APA attenuator 50, i.e., not between the APA lens 32 and transmitting optical fiber 30a as presently claimed. Claim 19 is thus patentable over the applied art of record.

Claims 20-24 depend from claim 19, and are considered patentable at least for the reason advanced with respect to claim 19.

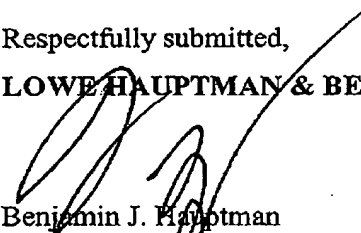
Each of the Examiner's rejections has been traversed. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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